

REMARKS

All the claims submitted for examination in this application have been rejected on formal and/or substantive grounds. Applicants have amended their claims and respectfully submit that all the claims currently in this application are patentable over the rejection of record.

Turning first to the formal grounds of rejection, Claims 12 and 16 stand rejected under 35 U.S.C. §112, first paragraph and under 35 U.S.C. §112, second paragraph.

It is unnecessary to discuss the basis for these grounds of rejection. Suffice it to say, Claims 12 and 16 have been cancelled.

Two substantive grounds of rejection have been imposed in the outstanding Official Action. The first of these grounds is directed to Claims 1-11 and 13-15. These claims stand rejected, under 35 U.S.C. § 101, as double patenting of Claims 1-14 of U.S. Patent 6,372,762.

Claims 7-11 and 13-15 have been cancelled. As such, the rejection of these claims is moot.

The subject matter of Claim 1 has been amended to a method of preventing the conditions recited in cancelled Claim 8, employing the class of substituted bicyclic derivatives originally recited in Claim 1. Support for this amendment is provided in the originally filed specification at Page 1, line 7 to Page 3, line 25.

Claim 1 is not subject to rejection as a double patenting of Claim 8 of U.S. Patent 6,372,762. Claim 8 of the '762 patent claims a method of treating the conditions now recited in amended Claim 1. However, Claim 1 is limited to a method of

preventing these diseases. As such, the invention of the present application is clearly distinguished from that of Claim 8 of the '762 patent.

Applicants submit that amended Claim 1 is patentable, under 35 U.S.C. §101, over the claims of U.S. Patent 6,372,762 insofar as Claim 1 is not the same invention as any of the claims of the '762 patent.

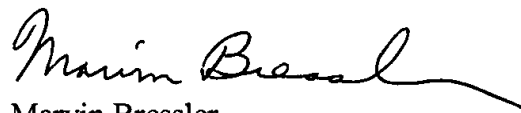
Claims 2-6 have been amended to recite a method of preventing the class of diseases recited in Claim 1, from which all of these claims ultimately dependent. Claims 2 to 6 are directed to subgenuses and species of the generic formula of Claim 1. It is emphasized that Claims 2 to 6 are patentable, under 35 USC § 101, over the claims of the '762 patent. None of the claims of the '762 patent are directed to a method of preventing the conditions recited in Claims 2 to 6, employing the compounds within the contemplation of these claims.

Patentability of Claims 1 to 6 is predicated upon the same grounds that predicated patentability of the claims of the parent application which issued as the '762 patent.

The second substantive ground of rejection is directed to Claims 12 and 16. These claims stand rejected under the judicially created doctrine of obviousness-type double patenting. It is unnecessary to discuss the merits of this ground of rejection insofar as Claims 12 and 16 have been cancelled.

The above amendment and remarks establish the patentable nature of all the claims currently in this application. Notice of Allowance and passage to issue of these claims, Claims 1-6, is therefore respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marvin Bressler", with a long horizontal flourish extending to the right.

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